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REMARKS

In response to the non-final Office Action of March 23, 2007, Applicant presents the foregoing claims addressing the formal issues raised by the Examiner and remarks regarding the rejections made. Upon considering these amendments and remarks, it is believed that the Examiner will agree that all claims patentably distinguish over the cited prior art and should be formally allowed.

First addressing the formal issues, the Examiner contends that claims 10 and 20 fail to comply with the definiteness requirement of Section 112, second paragraph, because “[i]t is not clear what heat resistance is encompassed by a ‘high heat resistance.’” As observed in the MPEP, “[t]he fact that claim language, including terms of degree, may not be precise does not automatically render [a] claim indefinite” MPEP 2173.05(b). Rather, “[a]cceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification.” *Id.*

In mentioning high heat resistance, Applicant’s specification gives examples of ways to achieve such feature. No showing is made that a skilled artisan would not understand the import of this limitation based on this teaching, but instead the Examiner simply contends (apparently, based on his opinion) that it is “not clear.” Respectfully, this does not constitute requisite substantial evidence that claims 10 and 20 lack definiteness. Withdrawal of the rejections under Section 112 is therefore in order.

Turning to the rejection of claim 25, the Examiner contends that either U.S. Patent No. 5,616,408 to Oleszczuk or U.S. Patent No. 5,804,512 to Lickfield disclose the exact same invention claimed. In support of this rejection, the contention is made that a “single mass of wet processed mass of fibrous mat . . . can be considered a multi-layered article.” Noteworthy, the Examiner’s current position is in stark and total contrast to the express admission in the Office Action dated July 11, 2005 that “neither Oleszczuk nor Lickfield specifically

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mentions a third layer of wet processed mat" (Office Action dated July 11, 2005, p. 3, para. 5, lines 4-5).

Of course, a proper anticipation rejection requires the exact same invention in the cited references. In making the rejection, the Examiner never establishes that either cited reference discloses the three claimed layers, but rather speculates that a single mass of fibers can be considered as a "multi-layered article." This statement is pure speculation, lacking the foundation of any substantial evidence in the record. As the Examiner correctly observes later in the instant Office Action, "unsupported arguments are no substitute for objective evidence." Accordingly, the anticipation rejections are infirm and should be withdrawn.

Next, claims 1-5, 11, 12, and 25 are rejected as anticipated by U.S. Patent No. 6,022,818 to Welchel et al. ("Welchel"). In making the rejections, the Examiner admits that Welchel discloses air-laid mats, but nevertheless contends that "this is identical to or only slightly different from the claimed article (wet-laid)." Again, however, no evidence whatsoever is provided to support this statement, let alone the requisite substantial evidence. Since "unsupported arguments are no substitute for objective evidence," and no such evidence establishes that an air-laid mat is "identical to or only slightly different from" the claimed wet-laid mat, withdrawal of the anticipation rejections based on Welchel is in order.

In an effort to substantiate these rejections despite the lack of objective evidence on key supporting points, the Examiner contends that "the patentability of a product does not depend on its method of production." No support is cited for this broad statement in any statute or case decision, and indeed it flies in the face of the precedential decisions cited by the Applicant in prior Actions supporting that a "wet processed mat" does not recite process steps. See *3M Innovative Props. Co. v. Avery Dennison Corp.*, 350 F.3d 1365, 1371-74 69 USPQ2d 1050 (Fed. Cir. 2003) (holding that "multiple embossed patterns" did not import

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a process limitation into a structural claim); *Hazani v. U.S. International Trade Commission*, 44 USPQ2d 1358 (Fed. Cir. 1997) (holding that the limitation "chemically engraved" in a claim "describes the product more by its structure than by the process used to obtain it."); *In re Garner*, 412 F.2d 276, 278-79, 162 USPQ 221, 223 (CCPA 1969) ("... the recitation of the particles as 'interbonded one to another by interfusion between the surfaces of the perlite particles' is as capable of being construed as a structural limitation as 'intermixed,' 'ground in place,' 'press fitted,' 'etched,' and 'welded,' all of which at one time or another have been separately held capable of construction as structural, rather than process, limitations").

Again citing to *In re Marosi* 218 USPQ 289 (Fed. Cir. 1983), which Applicant distinguished in the prior Office Action, the Examiner apparently continues to assert that the present claims are "product-by-process" claims, which therefore justifies shifting the burden of proving patentability to the Applicant. However, the present claims recite a liner/insulator having multiple layers of wet processed mat directly bonded together. The claims at issue are not "product-by-process" claims at all, but rather recite products in structural terms (claims 1-12 and 24-25) or methods of manufacture (claims 13-23). With respect to the product claims in particular, limitations such as "wet processed" when applied to claim elements such as mats have long been held to qualify as structural, rather than process limitations. See *In re Garner*, *supra*.

In responding, the Examiner takes the Applicant's assertion completely out of context. Contending that none of the claims at issue are in product-by-process form, Applicant in the most recent response stated that the claims "recite products in structural terms and methods of manufacture." This was a combined reference to claims 1-12 and 24-25, which "recite products in structural terms" and claims 13-23, which recite "methods of manufacture." Clearly, none of the product claims "recite[e] a product in terms of method of manufacture,"

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which as noted by the Examiner is "precisely the description of a product-by-process limitation."

Claims 1-5, 9-15, 19-22, and 24-25 also stand rejected as obvious based on the combination of Oleszczuk et al. and Lickfield et al. as primary references, in further view of Welchel. According to the Examiner, neither of the primary references "mention at least one adjacent additional layer of different fiber formulation," as expressly required by these claims. Although these primary references broadly mention that that the layers of the disclosed article "may be directly thermally bonded," it remains the case that neither teaches two layers of wet processed mat directly bonded together, as the claims at issue also expressly require. Indeed, the cited passages from the Oleszczuk et al. and Lickfield et al. references specifically teach bonding the wet laid layers 14, 16 with the intermediate meltblown layer 12 sandwiched between them, rather than to each other. Accordingly, it is a fact that these "primary" references do not teach direct bonding of any wet laid layers 14, 16 together.

In an effort to supply this missing teaching, the secondary Welchel reference is cited for the proposition that it is "known in the nonwoven laminate art to use an additional nonwoven layer with a different fiber formulation from the adjacent layer, so that the surface is more aesthetically pleasing to the touch and more comfortable to the user" (Office Action, p. 6, ¶2). Even assuming this statement is true, absolutely no teaching, motivation or suggestion of providing directly bonded layers of wet processed mat with different fiber formulations is identified anywhere in Welchel or otherwise in the prior art. Indeed, such an arrangement is contraindicated by the Oleszczuk et al. and Lickfield et al. references, since sandwiching a meltblown microfiber layer 12 between the two outer layers 14, 16 is a critical teaching of each of them. In other words, the outer layers 14, 16 are neither of different fiber formulations nor directly bonded together, as the claims under rejection require.

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Welchel et al. simply does not supply the critical missing teaching of two layers of wet processed mat, as claimed, having different fiber formulations directly bonded together. As Applicant previously pointed out, even if the "second top layer" 105 identified in Welchel et al. does have a "different fiber formulation," it is neither wet processed, nor is it directly bonded to another wet processed layer, as expressly required by claims 1 and 13.

In response to Applicant's argument in this regard, the Examiner contends that "it is not necessary to rely on Welchel to teach the wet processing of the layers because Oleszczuk and Lickfield already disclose that additional 'supporting' (wet processed mat) layers may be added to the composite article" (emphasis added). Applicant respectfully submits that this statement is simply not accurate, since Oleszczuk et al. and Lickfield et al. do not in any of the passages cited disclose that an additional "wet processed mat" layer may be added to the article, let alone directly bonded to another wet processed mat layer as required by the claims at issue. While these references include an omnibus statement regarding the possible addition of unspecified layers in an unspecified manner in an effort to meet the specific terms of the claims at issue, this hardly qualifies as the requisite substantial evidence necessary to support a proper obviousness rejection. *See In re Zurko*, 59 USPQ2d 1693 (Fed. Cir. 2001) (recognizing the need for "some concrete evidence in the record in support of" findings of obviousness). Stated another way, no "reasonable mind might accept as adequate" the teachings of Oleszczuk et al. and Lickfield et al. as to the addition of various additional layers as supporting the conclusion advanced by the Examiner that it would as a result of the cited teachings be obvious to directly bond a wet processed mat of a different fiber formulation to either of the layers 14, 16 disclosed in these references.

Likewise, the requisite substantial evidence does not support the ultimate conclusion reached as to the obviousness of the claimed inventions. The Examiner concludes based on the teachings of the cited references that a skilled

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artisan would have found it obvious to "directly bond an additional wet processed bicomponent staple fiber mat supporting layer, with a different fiber formulation . . . because the additional wet processed bicomponent staple fiber mat supporting layer would allow the surface to be more aesthetically planning to the touch and more comfortable to the user" (Office Action, pp. 6-7).

The difficulty with this position is that no evidence in the record supports the conclusion that adding a wet processed mat layer having a different fiber formulation would produce the stated result. As implicitly admitted by the Examiner, Welchel does not mention any wet processed mat layer directly bonded to another wet processed mat layer of the type claimed having a different fiber formulation, so it cannot support the conclusion reached. Moreover, the Examiner expressly admits that Oleczuk et al. and Lickfield et al. "do not appear to specifically mention at least one adjacent additional layer of different fiber formulation" (*Id.*). The Examiner's conclusion is thus a *non sequitur*, since the fact that Welchel teaches that a different fiber diameter or denier may create a surface more "aesthetically more pleasing to the touch" would not in any way provide a reason for a skilled artisan to directly bond two wet processed mats having different fiber formulations together as required by the claim.

Turning for a moment to method claim 13 alone, the case for patentability over the cited references is even more compelling. Besides providing two layers of wet processed mat of different fiber formulations, this claim specifically requires the step of "applying sufficient heat and pressure to said first and second layers of mat to bond said first layer and said second layer directly together and form said liner/insulator." As admitted by the Examiner, the primary references do not in any way teach directly bonding layers of wet processed mat as claimed. Hence, they cannot possibly teach or suggest the step of "applying heat and pressure" to two such layers in order to bond them. Even if it is presumed for the sake of argument that Welchel teaches adding a layer of

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mat as claimed, it does not in any way teach or suggest directly bonding two layers of wet processed mat having different fiber formulations using heat and pressure. Accordingly, even if the teachings of the three references are combined, they would in no way disclose all limitations of process claim 13, as required for a *prima facie* case of obviousness. See MPEP 2143.03 ("To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.").

With regard to claims 6-8 and 16-18, Oleszczuk et al. and Lickfield et al. fail to teach or suggest a liner/insulator including first and second layers of wet processed mat directly bonded together, wherein the first and second layers have different fiber formulations. Welchel, as described above, does not supply this missing teaching, either, and Insley does nothing to address this shortcoming of the other references. Also, the Examiner's stated reason for making the combination ("successfully practicing the invention") is mere argument, and does not qualify as objective evidence of the requisite reason for arriving at the claimed inventions. Accordingly, a *prima facie* case of obviousness is lacking with respect to claims 6-8 and 16-18.

As for claim 23, which stands rejected as obvious based on the teachings of five different references, the Oleszczuk, Lickfield, and Welchel references fail to teach or suggest a liner/insulator including first and second layers of wet processed mat directly bonded together where those first and second layers have different fiber formulations. Bansal and Malaney do nothing to address this shortcoming of the other references. Accordingly, claim 23 patentably distinguishes over the cited art and should also be allowed.

As for dependent claim 24, the Examiner contends that its terms are met by the three references cited against claim 1 because "the first and second layers have different fiber compositions because one layer is composed of fibers with a small diameter while the other layer is composed of fibers with a larger diameter" (Office Action, p. 8, ¶1). Although not made clear despite Applicant's

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request, it is presumed that the Examiner is relying on the Welchel reference in support of this statement. Regardless, the statement made ignores the plain and ordinary meaning of the term "composition," as evidenced by the definition provided in the previous response. This ordinary meaning is entirely consistent with that accorded by Applicant's specification, which describes the fibers of one layer 4 as possibly comprising polyolefins and polyacetate, with the fibers of the other layer 2 including natural fibers such as hemp and kenaf. In contending that the different diameters of Welchel et al. qualify as different "fiber compositions," the Examiner improperly construes the claim so as to alter the ordinary meaning of the term "composition," contrary to what would be understood by a skilled artisan. *See In re Cortright*, 165 F.3d 1353, 1358, 49 USPQ2d 1464 (Fed. Cir. 1999) ("Although the PTO must give claims their broadest reasonable interpretation, this interpretation must be consistent with the one that those skilled in the art would reach.") (emphasis added).

Apparently recognizing the shortcoming of Welchel in this regard, the Examiner goes on to contend that Oleszczuk and Lickfield "each disclose that at least one of the outer webs may be treated with a treatment agent to render any one of a number of desired properties to the fabric" (Office Action, p. 8, ¶2). This assertion, even if true, does not support the rejection of claim 24 on obviousness grounds for several reasons. First of all, the two "webs" 14, 16 at issue in Oleszczuk and Lickfield are not directly bonded together, and in fact these references teach away from such an arrangement by requiring an intermediate layer 12. Thus, even if the webs 14, 16 sandwiching an intermediate layer 12 may include "treatment agents," this *per se* does not in any way meet the terms of claim 24.

Secondly, no evidence in the record establishes that applying a "treatment agent" in the manner suggested would make the fiber composition different in the layers. In other words, it has not been shown that the "elements or compounds" making up the fibers of each layer 12, 16 would change, even if the

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treatments mentioned in the references were applied in the manner suggested. Indeed, the Examiner expressly admits that Oleszczuk and Lickfield "fail to mention at least one adjacent additional layer of different fiber formulation", which means that the terms of claim 24 cannot possibly be met by either reference. In the absence of such a showing based on the requisite substantial evidence, the invention of claim 24 as properly construed cannot be considered either anticipated by or obvious in view of these references.

In responding to Applicant's arguments, the Examiner makes the frankly curious contention that "applicant asserts that the applied prior art fails to teach or suggest that the first layer has a different composition from the second layer" but "the features upon which the applicant relies are not recited" in claim 24. According to the Examiner, this claim "simply states that the layers have different fiber compositions, not necessarily different from each other" (Office Action, paragraph bridging pp. 19-20, emphasis added).

The exact wording of claim 24 is that "the first and second layers have different fiber compositions." Using the Examiner's interpretation of claim 24, the layers are "not necessarily different from each other," which is in stark and total contrast to the plain language used. The Examiner offers no support whatsoever for the proposed claim construction, and instead improperly construes the claim so as to alter the ordinary meaning of the word "different" means "the same." This is not only contrary to logic, but also contrary to what would be understood by a skilled artisan. *See In re Cortright, supra.*

Claims 1-5, 11-15, 21-22, and 25 are further rejected as obvious in light of Welchel "in view of anyone of" Holm, Cederblad, or D'Acchioli. While it is admitted that the primary Welchel reference does not disclose the claimed wet processed layers of mat directly bonded together, the secondary references purportedly disclose "that it is known in the art to form mats by a wet-laid or dry-laid process." Based on this teaching, the Examiner posits that it would have been obvious to make the claimed mats "from any suitable nonwoven material,

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such as dry laid or wet laid, because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability and desired characteristics."

Despite the Examiner failure to cite any rule, statute, case decision, or section of the Manual of Patent Examining Procedure in support of the broad proposition advanced in support of the rejections, Applicant notes that this appears to be a generalization of the holding of *In re Leshin* 227 F.2d 197, 125 USPQ 416 (CCPA 1960). In *Leshin*, the court held that selection of a known plastic to make a container of a type made of plastics prior to the invention was obvious.

The stark difference between *Leshin* and the present case is that the Applicant is not claiming a species of a known material used to make a prior art product. Rather, the Applicant is claiming a multi-layered wet laid mat, and the primary reference relied upon teaches an air-laid mat. Holm, Cederblad, or D'Acchioli do not even remotely teach or suggest a wet laid mat made of the claimed thermoplastic polymer staple fibers and thermoplastic bicomponent fibers, or that such when wet laid would be suitable for forming a multi-layered article. Indeed, an expressly stated goal of the Holm patent is to produce an article of natural fibers (see col. 1, lines 66-67), so it actually teaches away from the arrangement of Welchel. For these reasons, the Examiner has failed to set forth a *prima facie* case that it would be obvious to arrive at the claimed inventions based on the cited combination of references.

A secondary reason that a *prima facie* case of obviousness is lacking is the complete and total failure of the Examiner to identify any evidence of a reason for using the product of Holm, Cederblad, or D'Acchioli in the arrangement of Welchel. Evidentiary support of a reason for the combination is undoubtedly still a requirement of a *prima facie* case of obviousness. See Memorandum of Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007 ("in formulating a rejection under 35 U.S.C. 103(a) based upon a combination of

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prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed . . .") (emphasis added). The Examiner cites no decision in support of waiving this requirement, or evidence establishing that the substitution of a wet laid mat in the structure of Welchel would be a matter of only routine skill. Accordingly, withdrawal of the rejections as lacking proper findings of evidentiary facts in support of a reason to substitute a wet laid mat for the air laid mat in Welchel is in order.

As for the obviousness rejection of claim 25, Welchel does not disclose any third layer of bicomponent fibers, period, and indeed specifically teaches that one of the layers must consist solely of cellulosic fibers (see col. 4, lines 36-39). The secondary references cited do not in any way supply this missing teaching, and instead relate only to air laid mats. Accordingly, none of these references nor any other substantial evidence in the record teaches or suggests the limitations of new claim 25.

The Examiner further cites to Holm, Cederblad, or D'Acchioli in making further obviousness rejections of claims 6-8, 16-18, 19, 20, 23, and 24 in combination with Welchel, Insley, Bansal, Malaney or Lickfield, as previously applied in rejecting these same claims as "obvious." However, these rejections appear to simply be the same rejections made elsewhere without reference to Holm, Cederblad, or D'Acchioli, and simply restated under a different heading. Holm, Cederblad, or D'Acchioli are never mentioned for any reason in the Examiner's formulation of a position regarding *prima facie* obviousness of these claims. Since Applicant has addressed and overcome the primary rejections made, and Holm, Cederblad, or D'Acchioli do not in any way supply the missing teachings (a point with which the Examiner seems to agree, since these references are not at all used as evidence in the rejections), it is believed that a *prima facie* case of obviousness is lacking for the reasons provided above, and withdrawal of these rejections in order.

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In final analysis, none of the references cited teach or suggest the inventions of claims 1 and 13 (namely, two wet processed mat layers having different fiber formulations that are directly bonded together). Such a teaching or suggestion is undoubtedly a critical requirement of a *prima facie* case of obviousness. In view of this missing teaching, it also cannot be the case that a skilled artisan reviewing these references would in any way be compelled or motivated to modify the corresponding wet-laid layers 14, 16 of the primary references to have different fiber formulations and also to be directly bonded. Accordingly, there is simply no motivation to combine the references as proposed, which of course is a further crucial requirement of a *prima facie* case of obviousness. Therefore, claims 1 and 13 as well as claims 2-5, 9-12, 14-15 and 19-22 dependent thereon should be formally allowed. Upon careful review and consideration it is believed the Examiner will agree with this proposition. Accordingly, the issuance of a formal Notice of Allowance is earnestly solicited. Any fees required in connection with this submission may be debited to Deposit Account 50-0568.

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